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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/770,931 | 01/26/2001 | John H. Schneider | 00.05.12.1 | 8223 |

7590

09/23/2003

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EXAMINER

YU, GINA C

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 09/23/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/770,931

Applicant(s)

SCHNEIDER ET AL.

Examiner

Gina C. Yu

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-30 and 32-35 is/are pending in the application.
- 4a) Of the above claim(s) 29,32 and 33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-28, 30, 34, and 35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Receipt is acknowledged of Response filed on July 11, 2003. Rejections under 35 U.S.C. § 103 (a) as indicated in the previous Office action dated July 11, 2003 are maintained for the reasons of record.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 16-28, 30, 34 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitchell et al. (US 5741433) ("Mitchell") in view of Vijayendran et al. (US 5173526) ("Vijayendran").

Rejection is maintained for the reasons of record.

Response to Arguments

Applicant's arguments filed on July 11, 2003 have been fully considered but they are not persuasive.

Applicants argue that Mitchell somehow implies that the copolymer of vinyl and polyurethane would some produce a "sticky/non film former vinyl with the polyurethane". Examiner finds the argument unpersuasive, since Vijayendran teaches that the same polymer used in the applicants' invention is useful as film-forming polymer with flexibility, providing the motivation to use the prior art as a coating material.

The vinyl/polyurethane polymer as claimed by the applicants are known in the art as conventional coating materials to protect the substrate from scuff, abrasion, alcohol, soap, and oils. See col. 1, lines 11 – 15. In response to applicant's argument that no

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motivation to use the polymer as a permeable membrane exist, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See Ex parte Obiaya, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). In this case, applicants disclose in the specification that the invention uses the prior art vinyl/polyurethane polymer. It cannot be said that the same polymer that is used in the invention has the permeable properties that the prior art does not.

Furthermore, while applicants argue that there is no motivation to use the polymer as a permeable membrane because the prior art is intended as a protected coating material, examiner notes that the disclosure of the Vijayendran does not necessarily suggest that the polymer forms a complete barrier to aqueous environment. For example, the reference teaches that the polymer has a "good balance of protection from solvents, corrodants, abrasion and good and flexibility". See col. 11, line 30-34.

Examiner takes the position that a skilled artisan would have found the inference that the patentee had to compromise between the complete barrier function of the polymer, as there is any, and the flexibility of the polymer in order to achieve the balance between the protection and flexible properties of the polymer. Furthermore, permeability occurs even by transportation of water vapor through the membrane, rather than the liquid itself alone. See Mitchell, col. 5, lines 36 - 62. It is also well known in the art that a polymeric coating material having good moisture barrier function is still desirable for constant controlled release of the core material in a capsule because such polymer greatly reduces the rate of dissolution of the active material. See Mitchell, col.

5, line 63 – col. 6, line 2. Examiner takes the position that the teaching here indicates that even the polymers with good moisture barrier function are still permeable. Thus, the collective teaching of the Mitchell and Vijayendran references provide the expectation that even the Vijayendran vinyl/polyurethane polymer would be suitable as the coating material of the instant invention or the Mitchell invention, which provide the sufficient moisture barrier to provide both protection of the core material against the aqueous environment and the permeable property which is necessary to achieve the constant controlled release.

Applicants further argue that that there is no indication in either Mitchell or Vijayendran that polyurethane/vinyl hybrid polymer is a conventional ingredient well known in the art. Applicants are reminded that the obviousness standard is measured by what an ordinary skill in the art would have known at the time of the present invention, which is the filing date of the application. At the time of the present invention, both Mitchell or Vijayendran patents were available to the skilled artisan, thus the prima facie obviousness rejection is proper.

Conclusion

No claims are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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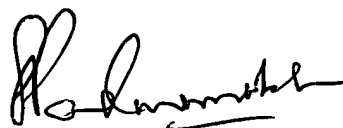
mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-308-3951.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 703-305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu
Patent Examiner


SREENI PADMANABHAN
PRIMARY EXAMINER
9/22/03